

REMARKS

Status of the claims

In his August 22, 2003, Office Action, the Examiner rejected claim 8 under § 112, ¶ 1; and rejected claims 1-20 based on obviousness.

Applicant has amended claim 8 to overcome the section 112 rejection. Applicant has amended claim 1 to overcome the section 103 rejections. Applicant has also cancelled claims 2 and 3 and amended claims 6 and 8 to conform with the amendments to claim 1. In addition, Applicant has added claims 21-25, the subject matter of which is supported by pages 2-3 and 8-17 and Figures 2-20.

Section 112, ¶ 1 Rejections

The Examiner maintained the rejection of claim 8 and helpfully explained, for the benefit of the undersigned, who does not pretend to be a person of ordinary skill in the art, the difference between “defining a database management system” and “implementing a database.” The Examiner noted that several sections on pages 9-12 of the application were directed not to defining a DBMS, i.e., a “layer of software between the physical database and the user,” but instead to exporting a field list for database implementation. Office Action, at 11.

Applicant has therefore amended claim 8 to recite “the step of implementing a database to collect and store data according to said field list” instead of the former “step of defining a database management system, said database management system being adapted to collect and store data according to said field list.” Applicant believes the amendment to be responsive to and sufficient to overcome the Examiner’s rejection.

Section 103 Rejections

The Examiner maintained the rejection of claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Sevcik et al., U.S. Patent No. 6,330,542 B1, entitled “Automated Internet Quoting and Procurement System and Process for Commercial Printing.”

Applicant has amended claim 1 and respectfully requests reconsideration and withdrawal of the rejection in light of that amendment and the following arguments.

The Examiner’s office action focused significant attention on dictionary definitions of the words “profile” and “predeterminable.” See OA at 5, 7. Applicant has amended claim 1 to define minimal content for the predeterminable profile and to add the following elements:

- generating a *prototypical product record* that is *company-tailored*.
- defining the *prototypical product record* as comprising a *template defining the placement and typography of a plurality of informational elements* for printing on a company-tailored business card or stationery product.

- having the requestor interface enable the user to select and order a company-tailored business card or stationery product *according to the company-tailored prototypical product record and a predeterminable profile*; and
- providing that the predeterminable profile *defines content for one or more of the informational elements* provided by the template.

These amendments distinguish the claimed invention from Sevcik because:

- Sevcik provides an interface with which customers can procure quotes for printing jobs in accordance with a catalog of stationery and business card products. Sevcik provides the same catalog to all of its customers. Sevcik does not teach, disclose or suggest a system for customizing a prototypical product record for a specific company.
- Sevcik does not disclose a template defining the placement and typography of informational elements to be printed on a business card or stationery product.
- While Sevcik enables a customer to select and order a print job from an online catalog, Sevcik does not teach, disclose, or suggest limiting that selection to a company-tailored prototypical product record and a predeterminable profile that defines content for one or more of the informational elements provided by the template.
- Finally, as argued in Applicant's previous response, Sevcik does not teach, disclose, or suggest processing the user's print order through a processor interface, said processor interface being adapted to directly generate a pre-press product automatically incorporating said predeterminable profile into said tailored product.

Applicant has also added a new independent method claim (claim 21), comprising the steps of:

- providing a set of printable stationery products;
- customizing templates to correspond with each stationery product in the set, wherein the template defines a plurality of common and specific informational elements for printing on the stationery product, and wherein the template also defines the placement and typographical settings of the informational elements to be printed on the stationery product (supported by, inter alia, page 9, lines 15-23; page 10, lines 8-20);
- providing predefined informational content for the common informational elements of the customized templates, including for at least one of the common informational elements informational content that identifies a specific organization (supported by, inter alia, page 10, lines 17-20);
- providing a requestor interface for entry of a print order by a user associated with that organization, the requestor interface being adapted to enable the user to select a

- stationery product from the set of printable stationery products, the requestor interface being further adapted to enable the user to define or select a profile comprising informational content for the specific informational elements of the customized templates but which denies the user any ability to define or modify one or more of the common informational elements of the customized templates (supported by, inter alia, page 11, lines 9-14, page 12, lines 7-9; page 12, line 23 – page 24, line 8); and
- in response to the print order, automatically generating a pre-press product incorporating both the predefined informational content for the common informational elements of the customized templates and the informational content from the user-defined or user-selected profile.

Claim 21 is patentable over Sevcik because:

- Sevcik does not teach, disclose or suggest a system for customizing templates for stationery products that define a plurality of informational elements.
- Sevcik does not teach, disclose or suggest a system for customizing templates for stationery products that define the placement and typographical settings of those informational elements.
- Sevcik does not teach, disclose or suggest a system for providing predefined informational content for the common informational elements, including content identifying a specific organization.
- Sevcik does not disclose a requestor interface that enables the user to define the informational content of only the specific informational elements while denying the user the ability to define or modify the common informational elements.
- Finally, as argued in Applicant's previous response, Sevcik does not teach, disclose, or suggest processing the user's print order through a processor interface, said processor interface being adapted to directly generate a pre-press product automatically incorporating said predeterminable profile into said tailored product.

Applicant reiterates and incorporates by reference the arguments set forth in its response to the February 2003 Office Action regarding the teaching of Sevcik and its unsuitability for and teaching away from the modification urged by the Examiner. These arguments set forth further reasons why amended claim 1 and new claim 21 are patentable over Sevcik.

In addition, Applicant makes the following remarks in response to the Examiner's most recent Office Action.

To establish a prima facie case of obviousness, all of the following must be true: (1) all of the references relied upon must have been in the prior art (in a chronological sense); (2) all of the references must be either in the field of the inventor's endeavor or in a reasonably pertinent field;

(3) the prior art must suggest the desirability of the claimed invention (i.e., a reason, suggestion or motivation for combining the teachings of the references to produce the claimed invention must be present in the prior art); (4) the combination or modification must teach or suggest *all* of the claimed limitations; (5) a person of ordinary skill in the art must have had a reasonable expectation that the combination or modification would succeed, and (6) the proposed combination or modification cannot render the prior art unsatisfactory for its intended purpose.

The Examiner argues that "Sevcik creates pre-press products via other interfaces that use information from the profiles. Sevcik passes Pre-press product product data to print provider production systems for the purpose of creating, selling, and fulfilling orders for printed products." OA, at 7. Elsewhere, the Examiner argues that "Sevcik merges specific profile data, data entered via entry fields on various interfaces according to templates and prototypes to produce pre-press files." OA, at 13. Having read Sevcik, Applicant's attorney is not aware of any support for these assertions. Therefore, they are disputed.

On pages 7-8, the Examiner places emphasis on the words "may require" in Sevcik's remark that "a Print Provider *may require* additional information about a job *in order to begin*." Sevcik's use of the permissive word *may* is to be expected. It is a patent, after all. One of the first tenets of patent drafting is to never use words like "must," "essential," and "critical" when defining an invention, lest the argument be made that the claims need be amended to incorporate the limitation.

Sevcik's acknowledgement that additional information may be required does not prove the opposite. Sevcik does not teach or disclose sufficient information to enable a person of ordinary skill in the art to make and use a system in which the typography and placement of information elements is predefined so that such additional information is *not* required. See *Beakman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 U.S.P.Q.2d 1301, 1304 (Fed. Cir. 1989) ("In order to render a claimed apparatus of method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method."); *In re Wilder*, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970) ("[A] prima facie case is made out whenever a reference is shown to contain a disclosure which is specific as to every critical element of the appealed claims. However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within 'the possession of the public.'") (emphasis added)

On page 8, the Examiner argues that Sevcik's disclosure of a "Job History" online tracking system proves that Sevcik also performs all of the prepress processing. Sevcik, however, does not state or teach or suggest that its system does the prepress processing. Moreover, Sevcik does not teach or disclose sufficient information to enable a person of ordinary skill in the art to make and use a system in which the typography and placement of information elements is predefined so that such additional information is *not* required.

The Examiner argues that because Sevcik uses the word "procurement" in its title, the Abstract, and in the specification, and because the BARRONS Dictionary of Business defines

“procurement” as the acquisition of goods required to carry on an enterprise,¹ therefore “Sevcik print providers receive information that is sufficient to create printed product.” OA, at 6. The Examiner argues again, on page 13, that “[t]he output from Sevcik contains information sufficient to enable professional printers and typographers to bid on an order and fulfill an order.” And on page 18, the Examiner argues that “Sevcik discloses that specific company tailored product (sic) is sufficient for professional printers an (sic) typographers to create competitive cost quotes.”

Applicant respectfully disagrees. Yes, Sevcik provides enough information to enable printers to provide quotes. Yes, Sevcik assumes that print providers will receive additional information they need to fulfill the print order by some method or means, like contacting the customer. *See* Sevcik, col. 15, lines 19-22. But Sevcik does not indicate that *its system* provides sufficient information, e.g., about the placement and typographical settings of the informational elements to be printed on the stationery product, to create a printed product. Furthermore, Sevcik does not teach or disclose sufficient information to enable a person of ordinary skill in the art to make and use a system in which the typography and placement of information elements is predefined.

On page 13, the Examiner argues that “Sevcik merges specific profile data, data entered via entry fields on various interfaces according to templates and prototypes to produce a pre-press file.” The Examiner also argues that Sevcik teaches an interface with a plurality of fields to develop a plurality of product records. OA, at 13-14.

Applicants submit that the amendment to claim 1 defines the terms “profile,” “template,” and “prototypical product record” in a manner that renders these arguments moot. Sevcik clearly does not generate prototypical product records or templates or merge information in the manner recited by amended claim 1.

The Examiner relies extensively on facts claimed to be within his personal knowledge regarding (1) what was generally available to persons of ordinary skill in the art at the time the invention was made; and (2) what factors would have motivated them to modify the embodiments disclosed in existing references. The Examiner argues, for example, that:

- (1) One of ordinary skill in the art of electronic commerce at the time the invention was made would have been motivated to include in Sevcik the use of various types of prior art command sets (such as direct-to-plate and copier command sets) for the obvious reason that professional printers may have many different types of printing machines, depending on their specialties. OA, at 3 – **This is disputed because, as argued previously, Sevcik teaches that the print provider, not Sevcik’s system, fulfills the print order.**

¹ It is improper to rely on specific words of a carefully selected definition (one of many) of the word “procurement” to argue that Sevcik teaches something that it does not teach. Where a word is “used in so many senses, dependent upon the context, . . . the ordinary definitions of the dictionary throw but little light upon its signification in a given case.” *Watt v. Western Nuclear, Inc.*, 462 U.S. 36, 42 (1983).

- (2) Pre-press products may be command sets for direct-to-plate systems and for copier systems. OA, at 5 – **Agreed.**
- (3) Pre-press product product may differ depending on the type of system being used to produce a print product. OA, at 5, 17 – **Agreed.**
- (4) One of ordinary skill in the art at the time the invention was made would have known that it is customary to send direct-to-plate command sets to systems that require plates or copier command sets to systems that produce printed products via electronic copiers. OA, at 5, 17 – **Agreed that direct-to-plate command sets were known; disputed to the extent that the examiner is suggesting that it is “customary” to incorporate this in every system related to printing.**
- (5) A profile is a set of data that portrays the significant features of something. OA, at 5 – **Agreed.**
- (6) As would have been well known to one of ordinary skill in the art at the time the invention was made, professional printers may have many different types of printing machines, depending on their specialties. OA, at 15 – **Agreed.**
- (7) One of ordinary skill in the art at the time the invention was made would have known to use HTML and scripting languages on the Internet. Scripting languages may be used on both a client-side and on a server-side of a network. On a server, scripts may be coded to merge some or all of the data received from a client to other data that already exists on any of a server’s databases. The data stored in a server database may be of any data type. OA, at 16. **Agreed with the qualification that those of ordinary skill in the art lacked the foresight, vision, or motivation to use them to practice the claimed invention.²**
- (8) “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Sevcik with knowledge generally available to those of ordinary skill in the art and disclose the use of HTML and scripting languages.” OA, at 16 – **Disputed because, among other things, there was no teaching, motivation, or adequate enabling disclosure to modify Sevcik to even meet the limitations of claim 1.**
- (9) “[O]ne of ordinary skill in the art at the time the invention was made would have known to send copier commands to systems that produce printed products via electronic copying machines.” OA, at 17 – **Agreed with the qualification that a person of ordinary skill in the art would not find it obvious to do this for a product that has not been proofed, or without first defining the content, typography, and placement of the information to be printed on the stationery. Because Sevcik does not teach these definitional steps, it would not be obvious to modify Sevcik to send commands to produce printed products.**
- (10) “Therefore, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time the invention was made to combine Sevcik with knowledge generally available to those of ordinary skill in the art at the time the invention was made to disclose the use of command sets in the information sent to printing professionals.” OA, at 17 – **Disputed for the same reasons listed above.**

² Relevant to claims 17-20.

- (11) “One of ordinary skill in the art of electronic commerce at the time the invention was made would have been motivated to combine Sevcik with knowledge generally available to those of ordinary skill in the art at the time the invention was made to disclose the use of command sets in information sent to printing professionals for the obvious reason that printing professionals use different types of hardware and software for printing.” OA, at 17 – **Disputed for the same reasons listed above and also because of the impracticality of modifying the Sevcik system to not only provide a common marketplace for competing print providers, but also maintain the latest drivers for all of the latest printers, copiers, and press systems used or purchased by those print providers.**
- (12) “[O]ne of ordinary skill at the time the invention was made would have known that typographical information includes tracking, text and graphics adjustment data. Without information such as font size, font type, characters per inch, fixed or variable text size, image size and placement, one of ordinary skill in the art of printing and typesetting may have insufficient details to provide competitive estimates, as is taught by Sevcik.” OA, at 18 – **Disputed. Printers, mechanics, patent attorneys, and bidders of all types provide quotes and bids all the time without having all of the information they need to perform the task. A printer does not need to know the typographical details to provide a quote. A printer’s main costs are the printing equipment, the stationery, and the ink. The type of font selected, etc., will have an extremely marginal effect on the cost. Therefore, this does not provide the motivation. Also, the costs of collecting and processing all of this additional information would overwhelm the stated motivation to collect and process it.**
- (13) “[I]f a print provider does not obtain sufficient information to produce a pleasing product according to specific guidelines, the print provider may lose customers, since customers may be very disappointed in the items they receive. Lost customers means lost business and lost revenue. Providing pleasing, accurate products according to specifications may produce happy customers who will bring back repeat business and recommend the particular print provider to others.” OA, at 18. **Agreed, but this provides no motivation for modifying Sevcik. The fact that Sevcik does not automate the order-to-prepress product generation process does not prevent print providers from obtaining sufficient information from their customers to produce pleasing products. Furthermore, print providers and platform providers have different motives. Any motivation to modify Sevcik would be overwhelmed by the countervailing motivation to avoid the complexity and enormous costs of making that modification.**

As seen above, Applicant disputes some but not all of these assertions. Applicant particularly disputes the Examiner’s assertions that the common knowledge possessed by those of ordinary skill in the art would have motivated them to modify Sevcik in the manner recited in the claims. The Examiner accused Applicant of failing to address all of the Examiner’s arguments in the previous Office Action.³ But the Examiner’s own office action entirely

³ The Examiner stated that the arguments in Applicant’s prior response “do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the

disregarded the arguments made on page 22 of Applicant's prior response. *See* MPEP 707.07(f) ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.").

The Examiner also remarked that the term "ready-to-print PDF" does not appear in Applicant's specifications or claims. However, the undersigned would stress that the plain and ordinary meaning of the term "prepress product" encompasses (in addition to the specification's inclusion of commands to copiers and direct-to-plate systems) both a printed product (that may be, for example, printed on lesser quality paper or with different lesser quality inks) and a visual representation of a product to be printed (i.e., an almost-WYSIWIG on-screen computer monitor prepress proof) that closely approximates the final product to be printed.⁴ Page 17 of the specification contemplates that "the user requestor and/or purchasing agent could be given the opportunity to preview the finished product at the time of order entry or approval."


Applicant respectfully asks that the section 103 rejection be withdrawn and the claims be allowed. In the alternative, Applicant asks that the Examiner produce an affidavit supporting those assertions regarding common knowledge that Applicant has indicated, above, that it disputes.

CONCLUSION

Having addressed all matters raised by the Examiner's August 22, 2003, Office Action, Applicants respectfully request that the claims be allowed.

Respectfully submitted,

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invention was made." OA, at 4. Applicant respectfully disagrees. To overcome a rejection, Applicant does not have to dispute each and every assertion made in the Office Action. Applicant does not dispute, for example, that at the time of Applicant's invention, there were various types of prior art command sets, printing machines, and software. But Applicant clearly challenged the Examiner's assertion that persons of ordinary skill in the art would have been *motivated* to modify Sevcik. See pages 17-24, and especially page 22, of Applicant's Response to the February 11, 2003, Office Action. Applicant's response was *unusually* thorough and complete.

⁴ See <http://desktoppub.about.com/cs/basic/g/prepressproof.htm>;
<http://desktoppub.about.com/library/weekly/aa112499.htm>.

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